

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(beaven01.002)

5 **Applicant:** Douglas F. Beaven, et al. **Confirmation No:** 1530

Application No: 10/765,424 **Group Art Unit:** 3623

Filed: 1/27/04 **Examiner:** Deshpande, Kalyan K.

10 **Title:** *System for performing collaborative tasks*

15 Commissioner for Patents
 Alexandria, VA 22313-1450

Response to a Non-final Office action under 37 C.F.R. 1.111

Summary of the prosecution

20 Applicants filed an RCE in the above application with a *Submission* that amended the claims to overcome a double patenting rejection on the basis of the closely related application USSN 09/312,740 and in order to gain rapid allowance for their claims. In so doing, they were not and are not conceding either that the rejection in the final Office action that preceded the RCE on the basis of Knoth, Tools for a collaborative World,

25 Computer Aided Engineering, April 1997, 9.40-47 was proper or that the claims were anticipated or rendered obvious by U.S. patent 6,442,557, Buteau, et al., *Evaluation of enterprise architecture model including relational database*, filed 2/27/98, which was cited in the prosecution of USSN 09/312,740 and was cited by Applicants in the present application. Applicants are consequently retaining their right to file a divisional

30 application with broader claims than the ones presently contained in this application.

In his first non-final Office action in the RCE, mailed 11/30/2006, Examiner made no further mention of the double patenting rejection, rejected claim 43 under 37 C.F.R. 1.75(c) as an improper dependent claim, and rejected all claims under 35 U.S.C. 103 as

35 obvious over the combination of a new reference, U.S. patent 6,157, 915, Bhaskaran, et al., *Method and apparatus for collaboratively managing supply chains*, filed Aug. 7,

1998 and issued Dec. 5, 2000 (henceforth "Bhaskaran"), and Official Notice. Applicants are traversing the rejections.

Traversal

5 *The rejection of claim 43*

This claim is a dependent Beauregard claim, i.e., it is a claim to a data storage device such as a mass storage device or a storage medium such as a CD-ROM that is characterized by the fact that it contains a program which, when executed, implements a system claimed in an apparatus claim or a method claimed in a method claim. The
10 patentability of any Beauregard claim is necessarily completely dependent on the patentability of the method or apparatus whose implementation code is stored on the storage device.

Applicants' attorney has been writing and the USPTO has been allowing such dependent
15 Beauregard claims for at least 10 years. The statutory provision governing dependent claims is 35 U.S.C. 112, fourth paragraph, which requires only that the dependent claim "contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed". Claim 43 satisfies the foregoing requirement: it refers back to claim 37 and claim 37 is further limited by the fact that what is claimed is not the
20 system of claim 37, but rather a storage device that contains code which implements the system set forth in claim 37. Because claim 43 is permitted by 35 U.S.C 112, 4th paragraph and 37 C.F.R. 1.75(c) and the relevant MPEP provisions merely restate the statutory requirement, Examiner's rejection is without basis.

25 *Overview of Applicants' system for supporting management of a collaborative activity*

Since Examiner is new to this application, Applicants respectfully refers Examiner to the overview of the goal, domain, and initiative hierarchies which may be found at page 25, line 6 through page 29, line 10 of Applicants' Specification and to the overview for the graphical user interface for the system, which is shown in FIG. 46 and discussed at page
30 36, line 11 through page 39, line 15. Claim 37 and its dependent claims are to be read and interpreted in light of the usage of claim terms in the overview. Important claim

terms include "model", "model entity", "goal model entity", "initiative model entity", "goal hierarchy", "initiative hierarchy", goal model entities that belong both to a goal hierarchy and an initiative hierarchy, and a user interface which permits "persons [who are not] specialists in information technology" to perform operations on model entities
 5 such as assigning them to a parent in a hierarchy and viewing the model entities in their hierarchies.

The disclosure of Bhaskaran

Bhaskaran discloses a system for collaboratively managing supply chains. FIG. 1 shows
 10 a graph of an example supply chain. It should be pointed out here that there is no indication in the disclosure of Bhaskaran that there is any representation of the supply chain graph of Fig. 1 in Bhaskaran's system or display of the supply chain graph in Bhaskaran's user interface. It should further be pointed out that the supply chain graph of FIG. 1 is not a hierarchy. In a hierarchy, a given node may have only one parent node.

15 The graphical user interface of Bhaskaran's system consists of "active documents", i.e., interactive screens in a Web browser. The active documents are domain task specific and access to the active documents is based on the role of the user in the supply chain. When an event occurs which requires reworking of one or more aspects of the supply chain,
 20 active documents are sent to the appropriate role players for their inputs. See col. 2, lines 33-46. FIGs. 2-8 present examples of the active documents.

FIG. 9 is a flowchart of the operation of the system. The operation is described at col. 7, line 40-col. 8, line 10. In overview, the supply chain is optimized by applying a Supply
 25 Capability Engine (SCE) to a scenario that describes a state of the supply chain and publishing a plan based on the supply chain as optimized for the scenario. When an event that affects the supply chain occurs, the role players are informed via the active documents of the event and use the active documents to cooperate in making a new scenario that takes the cause of the event into account. Once made, the supply chain is
 30 optimized for the new scenario. A number of iterations may be performed. When the

iterations reach a satisfactory result, a new plan is made that is based on the final optimization of the supply chain. The new plan is then published to the role players.

The rejection of Applicants' claim 37

5 Claim 37 as amended in the *Submission* that accompanied the RCE reads as follows:

1 **37. (new)** A system for supporting management of a collaborative activity by persons
 2 involved therein, the persons not being specialists in information technology and the
 3 system comprising:
 4 a representation of a model of the collaborative activity, the representation
 5 being accessible to a processor, the model of the collaborative activity including
 6 model entities that are organized into hierarchies and provide access to information
 7 concerning the collaborative activity,
 8 the model entities having types including
 9 a goal model entity type, model entities of the type representing goals
 10 and/or projects of the collaborative activity and
 11 an initiative model entity type, model entities of the type serving to
 12 relate goal model entities across the model, and
 13 the hierarchies including
 14 a goal hierarchy whose members include at least one goal model
 15 entity, a given goal model entity belonging to only a single goal hierarchy and
 16 an initiative hierarchy whose members include at least one initiative
 17 model entity, each initiative model entity being capable of having as children one or
 18 more initiative model entities and/or one or more goal model entities from one or
 19 more of the goal hierarchies; and
 20 a graphical user interface for the system which the processor provides to the
 21 persons, the graphical user interface permitting a person of the persons to perform
 22 operations on a model entity including creating, modifying, and/or deleting the model
 23 entity, assigning the model entity to a parent in a hierarchy, accessing and/or
 24 modifying the information concerning the collaborative activity via the model entity,
 25 and viewing model entities in a hierarchy of the hierarchies to which the model
 26 entities belong.
 27

Examiner's rejection of the claim is made under 35 U.S.C. 103 and is based on the combination of Bhaskaran and Official Notice that "the representation [of the model][is] accessible to a processor".

30 In order to make a rejection under 35 U.S.C. 103, Examiner must make a *prima facie* case that includes a demonstration that the combined references disclose *every limitation* of the claim under rejection. See MPEP 2142. In the present case, that means that Bhaskaran must disclose every limitation of claim 37 *other than* the limitation that "the representation [of the model][is] accessible to the processor".

When the foregoing summary of the disclosure of Bhaskaran is compared with claim 47, it is immediately apparent that many of the limitations which Bhaskaran must disclose if it is to serve as a basis of a rejection under 35 U.S.C. 103 are in fact not disclosed by the reference. To present
5 some examples:

The representation of the model of the collaborative activity

As already pointed out, the supply chain graph of FIG. 1 is not the "representation of the model" of the claim. The closest thing there is in Bhaskaran to a representation of the model of the
10 collaborative activity is the plan. There is no disclosure in Bhaskaran of the form of the plan, but since it is published (FIG. 9, S980), it appears to be a document. The plan certainly does not include "model entities that are organized into hierarchies", as required by the claim.

Model entities

There is in fact nothing in Bhaskaran that can be regarded as a model entity. Bhaskaran's active documents are used to inform users of Bhaskaran's system of events that may require reoptimization of the supply chain and to enable the users to collaborate in making the scenarios that are the basis of the reoptimization, but they are clearly not model entities. There being no
15 model entities, there can also be no model entities that have the goal model entity type or the initiative model entity type, as required by the claim.
20

Hierarchies

There being no hierarchies in Bhaskaran, there can be no goal or initiative hierarchies and a goal model entity cannot belong both to a goal hierarchy and an initiative hierarchy, all as required by
25 the claim.

The graphical user interface

Because there are no model entities disclosed in Bhaskaran, there can be no graphical user interface which permits a user to perform operations on a model entity. In particular, because there are no
30 hierarchies of model entities in Bhaskaran, there can be no operations of assigning a model entity to a parent in a hierarchy, of accessing and/or modifying the information concerning the collaborative

activity via the model entity, or of viewing the model entities in a hierarchy to which the model entity belongs, as required by claim 37.

Patentability of claim 37

5 Because Bhaskaran discloses *none* of the foregoing limitations of claim 37, Examiner has not made his *prima facie* case of obviousness and his rejection of claim 37 under 35 U.S.C. 103 as obvious over Bhaskaran and Official Notice is without foundation. Further, because claim 37 is patentable, so are all of the claims that are dependent from claim 37.

10 *Independent patentability of certain dependent claims*

From the foregoing discussion, it will be immediately clear that Bhaskaran also discloses nothing corresponding to domain model entities and domain hierarchies, as set forth in claim 38, or a display having "a first part in which the model entities of the hierarchy are viewed and a simultaneously visible second part in which a model entity selected by the user from the hierarchy is viewed", as set forth in claim 39, access to information via any of the model entities, as set forth 15 in claim 40, per-model entity access control, as set forth in claim 41, or viewing model entities as ordered by a value to which the model entities give access, as set forth in claim 42. Because these claims set forth limitations that are not disclosed in Bhaskaran, they are patentable in their own rights over the combination of Bhaskaran and Official Notice.

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Detailed rebuttal of Examiner's rejection of claim 37

Examiner finds the claimed representation of a model in FIG. 1 and its description at col. 3, lines 42-59; the figure is simply a graph of the supply chain; there is no indication in FIG. 1 itself, the cited location, or anywhere else in Bhaskaran that FIG. 1 shows "a representation of a model of the collaborative activity, the representation being accessible to the processor". Further, because FIG. 25 1 is not the claimed model, the nodes of the graph cannot be the claimed model entities; finally, as already pointed out, the graph of FIG. 1 is not a hierarchy. For goal model entity types, goal model entities, and goal hierarchies, as well as initiative model entity types, initiative model entities, and initiative hierarchies, Examiner refers Applicants to col. 3, lines 60-67, col. 4, lines 14-29, and FIGs. 30 1 and 5. What is described at these locations is how the supply chain of FIG. 1 works, why it is necessary for the participants in the supply chain to exchange information, and how the roles of the

participants in the supply chain determine their access to Bhaskaran's active documents. None of this has anything to do with model entities, model entity types, and hierarchies as they are described in Applicants' Specification and set forth in claim 37.

5 Examiner finds claim 37's graphical user interface at col. 5, lines 10-49, col. 6, lines 7-45, and FIGs. 2-4 of Bhaskaran. FIGs. 2-4 simply show examples of active documents; FIGs. 2-3 are described at col. 5, lines 10-49 and FIG. 4 is described at col. 6, lines 7-45. As may be immediately seen from a comparison of Applicants' FIG. 46 with Bhaskaran's FIGs. 2-4, Bhaskaran's graphical user interface does not permit anyone to perform an operation on anything that can be compared to
10 Applicants' model entities or on hierarchies of model entities, as required for Applicants' graphical user interface. Indeed, the fact that at this point, Examiner takes Bhaskaran's scenarios to include model entities only underlines the difficulties inherent in Examiner's rejection of claim 37.

Conclusion

15 Applicants have traversed all of Examiner's rejections and have thereby been completely responsive to Examiner's non-final Office action of 11/30/06 as required by 37 C.F.R. 1.111(b). Applicants consequently respectfully request that Examiner continue with his examination, as provided by 37 C.F.R. 1.111(a). No fees are believed to be required for this response. Should any be, please charge them to deposit account number 501315.

20 Respectfully submitted,

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